

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

I. Status of the Claims

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 1-3, 11-13, 15, 16, and 22 are requested to be amended. Exemplary support for these claims can be found throughout the specification as-filed, including paragraphs [0119] and [0120].

Claims 23-30 are requested to be added. Exemplary support for these claims can be found throughout the specification as-filed, including paragraphs [0119], [0120], and [0121].

After amending the claims as set forth above, claims 1-30 will be pending and subject to examination on the merits.

II. Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for reciting “optic.” According to the Office Action, “[c]laim 22 does not particularly point out and distinctly set forth what an ‘optic’ is.” Office Action at 2.

While not acquiescing in the propriety of the rejection, claim 22 no longer recites “optic.” Thus, the amendment renders the rejection moot.

II. Claim Rejections – 35 U.S.C. § 102(b)

Claim 1-22 stands rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent Application Publication US 2002/0176987 A1 to Yadav *et al.* According to the Office Action, “Paragraph no. [0097] discloses a solid state reaction between nanoscale powders of a material and at least one of its components by heating the combination to a temperature that completes the solid state reaction.” Office Action at 2. The Office Action cites paragraph [0109] for showing that the material may be a rare earth element.” *Id.* Applicant respectfully traverses this ground of rejection.

At the outset, the ‘987 application does not qualify as prior art under 35 U.S.C. § 102(b). The ‘987 application published on November 28, 2002, and the present application claims priority to an application filed January 31, 2003. Because the ‘987 application published was not published more than one year prior to the present application’s priority date, it is not prior art under Section 102(b). For at least this reason, the rejection should be withdrawn.

Even if considered prior art, the ‘987 patent fails to anticipate the present claims. As amended, claim 1 recites that a composition comprising nanoparticles is reacted with an “organic liquid” or “nitric acid.” Such a reaction allows the production of compounds, such as organometallics, nitrates, and oxides, as discussed in paragraphs [0119], [0120], and [0121] of the specification. The ‘987 application does not teach or suggest such a reaction. Indeed, the ‘987 application is silent on reacting nanoparticles with an “organic acid” or “nitric acid.” Accordingly, the ‘987 patent does not anticipate the presently claimed invention.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this ground of rejection.

CONCLUSION

Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.


The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 12-14-2006

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